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PATENT
CUSTOMER NUMBER, 34,986
Docket No. 01064.0011-08-000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Richard LEVY

Serial No.: 10/614,114

Filed: July 7, 2003

For: SUPERABSORBENT POLYMER
COMPOSITIONS ON A
SUBSTRATE (AS AMENDED)

Group Art Unit: 1774

Examiner: Jill Gray

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

APPELLANT'S REPLY BRIEF ON APPEAL PURSUANT TO 37 C.F.R. § 41.41

Appellant submits this Reply Brief to respond to the May 17, 2007 Examiner's Answer.

This brief sets forth additional authorities and arguments on which appellant will rely to maintain the appeal.

Related Appeals

The examiner states appellant has no related appeals pertaining to this application, even though the brief in chief sets out two appeals on applications that claim priority of the same parent application as the parent application for this case. Appellant maintains these comprise related appeals and further directs the Board's attention to a third related appeal,

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Application No. 10/614,114
Reply Brief
Dated: July 15, 2007

which appellant's attorney's search did not uncover at the time of filing the brief in chief.

Serial No. 09/357,957 July 21, 1999 (Attorney Docket 01064.0011-04-000)

The Rejection of Claims 57, 65, 73, 76, and 91 Under 35 U.S.C. § 112 Second Paragraph

The examiner rejects claims 57, 65, 73, 76, and 91 under 35 U.S.C. § 112 second paragraph requiring that the claims particularly point out and distinctly claim the subject matter which appellant regards as his invention, i.e., the claims do not clearly state the nature of the lubricating materials.

The examiner focuses on claims 57 and 65 in the first instances. In her claim construction, she argues they do not make clear which one or combination they cover of the three categories of materials recited (i.e., those of subparagraphs (1), (2), or (3)). The Brief on Appeal presented arguments against these rejections which appellant still maintains. Appellant further challenges the examiner's claim construction for the following reasons.

The Manual of Patent Examining Procedure ("MPEP") provides the following guidelines for claim construction:

During patent examination, the pending claims must be "given their broadest reasonable interpretation . . ." The Federal [Circuit]. . . expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard. . . . The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. . . . (MPEP § 2111, pp.2100-37, 38, Rev. 5 Aug. 2006 (citations omitted)).

Application No. 10/614,114
Reply Brief
Dated: July 15, 2007

The words of a claim must be given their plain meaning.
(MPEP § 2111.01, p.2100-38, Rev. 5 Aug. 2006 (citations omitted)).
"Plain meaning" refers to the ordinary and customary meaning given to
the term by those of ordinary skill in the art. (MPEP § 2111.01,
pp.2100-39, 40, Rev. 5 Aug. 2006 (citations omitted)).

After presenting several confusing constructions of these claims (Examiner's Answer, p.4, and p. 5,1st par.) in an attempt to show they allegedly lacked the 35 USC § 112 second paragraph requisites of particularly pointing out and distinctly claiming the subject matter of the invention; she concluded nonetheless that she actually understood them, stating, "[f]or the record, the examiner has interpreted the material for lubricating a surface of claims 57 and 65 a being one of the components of (1) or one of the components of (2) or one of the optional components of (3) or mixtures thereof." (Examiner's Answer, p. 5, 3rd par.). This is correct. The anomalous claim construction given in the Examiner's Answer, p.4, and p. 5,1st par. should not control.

The examiner also rejects claim 91 arguing that "lubricating metal, and alloy thereof, lubricating metal chalcogenide, halide carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a lubricant" of subparagraph (1) is an incomplete statement. Again, the Brief on Appeal presented arguments against these rejections which appellant still maintains. Appellant challenges this position of the examiner for the following reasons as well.

The examiner questions whether claim 91 contains complete statements and whether or not the structural elements of the claim relate to one another. Appellant answers both questions affirmatively and request the examiner to give the claim its broadest reasonable interpretation,

Application No. 10/614,114
Reply Brief
Dated: July 15, 2007

and the words of the claim their plain meaning, i.e., the customary meaning given to the terms by persons of ordinary skill in the art. (Cf. MPEP §§ 2111 and 2111.01 supra)

Multiple dependent claim 91 clearly shows the inter relation of the two sub paragraphs of the claim. The preamble subparagraph (1) identifies the parent claims from which it depends, either claim 57 or claim 65. Additionally, subparagraph (1) of claim 91 is the same as subparagraph (1) of claim 57 and subparagraph (1) of claim 65, and spells out the general class of lubricants employed in either claim 57 or claim 65. Claim 91, continues in the second subparagraph by reciting a list of subgeneric lubricants falling within the scope of subparagraph (1). Giving the claim its broadest reasonable interpretation, and the words of the claim their plain meaning, i.e., the customary meaning given to the terms by persons of ordinary skill in the art, would lead this skilled artisan to conclude that the claim, with this structure, does in fact contain complete statements and the structural elements of the claim do relate to one another by reciting a broad class of lubricants and then a class of lubricants that fall within this broad class. (Cf. MPEP §§ 2111 and 2111.01 supra) .

The examiner points out the language of line 4 of claim 91, i.e., "surface comprises" is also an incomplete statement. The phrase "surface comprises" contains a typographical error in that it includes the term "surface" which does not belong in this phrase. Appellant will delete "surface" by way of an amendment upon the conclusion of this appeal, but requests consideration of the claim in the form submitted in the "Claims" appendix of appellant's brief in chief, and as reproduced below.

91: The substrate of one of claims 57 or 65 wherein said:

Application No. 10/614,114
Reply Brief
Dated: July 15, 2007

(1) lubricating metal and alloy thereof, lubricating metal chalcogenide halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant comprises;

molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, cadmium oxide, borax, basic white lead, lead carbonate, lead monoxide, lead iodide, asbestos, talc, mica, zinc oxide, zinc phosphate, iron phosphate, manganese phosphate, carbon, graphite, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, or the Group VIII noble metals or mixtures thereof.

The Rejections Under 35 U.S.C. §§ 102 (b) and 103 (a)

The examiner rejects claims 57-63, 65-71, and 87-90 under 35 U.S.C. § 102 (b) as unpatentable over Freeman United States Patent No. 5,218,011 and claims 57-63, 65-71, 73, 76, and 87-91 under 35 U.S.C. § 103 (a) as unpatentable over Petinelli et al., United States Patent No. 4,621,169 (Petinelli), Freeman, and Marciano-Agostinelli et al., United States Patent No. 5,049,593 (Marciano-Agostinelli).

The 35 U.S.C. § 102 (b) Rejection Based on Freeman

Again, the Brief on Appeal presented arguments against the rejection based on Freeman which appellant still maintains. Appellant challenges the position of the examiner for the following reasons as well.

The examiner argues Freeman teaches superabsorbent polymers having the same water absorbency as the superabsorbents of the claims on appeal, i.e., greater than 100 times

Application No. 10/614,114
Reply Brief
Dated: July 15, 2007

their weight in water. As pointed out in the brief in chief, Freeman does not give the water absorbency of the superabsorbent polymers he uses. It could 40 or 50, and not the 100 or greater water absorbency called for by the claims on appeal. In any event, Freeman does not give the water absorbency of the polymers, nor can the skilled artisan learn anything about the water absorbency from Freeman.

The examiner only supports her rejection by a supposition of what the Freeman disclosure might say about water absorbency, without pointing to any part of Freeman or any other proof to support her supposition. The examiner argues in this regard:

Freeman teaches. . . [the use of] FAVOR C98 a crosslinked polyacrylic acid. . . the same superabsorbent polymer disclosed by applicant as absorbing greater than 100 times its weight in water which are [sic] the same superabsorbent polymers [sic] disclosed by applicants as absorbing greater than 100 times its weight in water. Accordingly, the examiner has reason to believe that the superabsorbent polymer of the prior art has the requisite absorption amount.

Examiner's Answer, p.6, par. 2. (Emphasis added).

In the first instance, appellant does not identify FAVOR® C96 as a superabsorbent polymer having a water absorbency greater than 100, and the manufacturer, Stockhausen G.m.b.H sells many polymers under the FAVOR® brand. The examiner, who has the burden of proof on this issue¹, points to nothing in the appellant's written description to support this statement, other than statements that appellant taught the use of FAVOR® brand polymers. Appellant has not found any technical literature that shows the water absorbency of FAVOR® C96. Neither has the examiner, or she would have cited it.

¹ In re Lee, 227 F.3d 1338, 1 U.S.P.Q.2nd 1430, 34 (Fed. Cir., 2002).

Application No. 10/614,114
Reply Brief
Dated: July 15, 2007

The rejection needs more than a statement from the examiner that she "has reason to believe that the superabsorbent polymer of the prior art has the requisite absorbtion amount." The rejection has to be supported by proof, In re Lee, 227 F.3d 1338, 1 USPQ 2d 1430, 34 (Fed. Cir., 2002). (Also See MPEP 2131.02, Rev. 5 Aug., 2006, citing Akzo Nobel, N.V. v. U.S. International Trade Comm'n, 808 F.2d 1471, 1 USPQ 2d 1241, (Fed.Cir. 1986) where claims to a process for making ARAMID® fibers using a 98% solution of sulfuric acid were not anticipated by a reference which disclosed using sulfuric acid solution but which did not disclose using a 98 % concentrated sulfuric acid solution.)

In this instance, the examiner has not offered any proof of the water absorbency of FAVOR® C96, but only a supposition. That is not enough to meet her burden of proof.

More importantly, and as pointed out in the brief in chief, Freeman does not teach the use of inorganic lubricants in his composition as called for by the claims on appeal. Freeman therefore does not anticipate appellant's claimed invention since it fails to show all elements of the claims. MPEP 2131.02 and Akzo, (supra).

The Rejection under 35 U.S.C. § 103 (a) Based on Petinelli,

Freeman and Marciano-Agostinelli

The Brief on Appeal presented arguments against the rejection based on Petinelli, Freeman and Marciano-Agostinelli, which appellant still maintains.

In view of the foregoing reasons and authorities, appellant requests the Board to reverse the examiner in all respects and remand the application to the examiner for the issuance of a

Application No. 10/614,114
Reply Brief
Dated: July 15, 2007

Notice of Allowance.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

Dated: July 15, 2007

By: /Robert J. Eichelburg, Reg. No. 23,057/
Robert J. Eichelburg

CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that this correspondence is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, facsimile telephone number (571) 273-8300 on the date indicated below.

By: /Robert J. Eichelburg, Reg. No. 23,057/
Robert J. Eichelburg

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